

Attorney Docket: Beiersdorf 653

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-4, 6 and 8-20 are pending in the application. The claims have been rejected under §§ 102 and 103.

In response, claim 1 has been amended to emphasize the elasticity requirement of the laminate. In addition, the claim has been amended to require that the adhesive coating be accessible for bonding to the subject's skin, rather than as a bonding means to appose adjacent layers as in Wood.

Claims 21-22 include limitations to the range of elasticity, such ranges being distinct from Wood. Masatoshi discloses no elasticity measurements.

New claim 23 is essentially identical to claim 1, except that the transitional phrase "consisting essentially" has been used to further specify that all layers in the laminate are elastic. Thus, laminates having layers that are substantially inelastic would not read on claim 23.

None of the amendments or new claims introduce new matter. Claims 21 and 22 were formulated from the data presented on page 13. In addition, the requirement for elasticity in all layers has been referred to throughout the specification; e.g., page 2, lines 17-21.

Attorney Docket: Bel rsdorf 653

Anticipation by US '374 to Wood

Examiner alleges that claims 1, 6, 15-16 are anticipated by Wood. Applicants respectfully disagree, especially in view of amended claim 1.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.

Respectfully, Wood does not satisfy the requirements of an anticipating reference.

First, it appears that Examiner has been reciting elements from Wood without proper consideration as to whether these elements are arranged as in the claimed laminate. The laminates in Wood's Figure 1 are not arranged as the claimed laminate; see Figure 2 in the specification. Note that in Wood's Figure 1(i) the two outer layers are represented as identical. This is not the case with the claimed laminate.

Claim 1 requires that each layer of the laminate is elastic. The specification does not disclose the desirability of including nonelastic layers or interspersing nonelastic regions within the layers. In contrast, this is precisely what Wood teaches.

Wood specifically requires nonelastic material to be incorporated into her laminate. See col. 3, Summary of Invention to col. 3 to col. 4, line 6; col. 4., lines 34-46, disclosing the particularly advantageous properties of the laminate being nonextensible in one direction.

Attorney Docket: Beiersdorf 653

Further, Wood teaches that his laminate "is capable of becoming microtextured...." Examiner hastily equates this with microembossed, as interpreted by Applicants. Applicants disagree with this characterization.

Microembossing is meant to distinguish from the larger patterned unit of macroembossing. This amounts to a difference of only about 4-fold difference in size, Page 9, 1st paragraph. However, it is not clear how this compares to Wood's laminate being capable of becoming microstructured. Is it or is it not microstructured? What is microstructure? It would appear that there is no enabling description that would allow persons in the art to use Wood's "microstructuring" to arrive at a microembossed laminate.

Respectfully, microstructured (apparently potentially resulting from the relaxation of the stretched material) has not been shown to be an equivalent of microembossing.

In sum, it is believed that amended claim is not anticipated by the Wood reference. Therefore the rejection under § 102 should be withdrawn.

Obviousness Over Masatoshi in View of Wood

I. Applicants respectfully point out that comparing the disclosed subject matter in Masatoshi to that of Wood reveals substantial differences. Further, these differences are of sufficient magnitude to negate any reasonable motivation to combine these references.

Whereas Masatoshi (Figs. 1, 2) discloses a typical laminate arrangement, i.e., Wood discloses a very different arrangement. See Wood Fig. 1. In addition, Wood demonstrates a composite of two distinct components intermingled components. In essence, it is virtually impossible in Wood to discern what is outside or inside. Which side is designed for contacting the skin?

This asymmetry of structure may be illustrated by considering Examiner's assertion that Wood discloses that the first layer is coextruded with an outer layer and a tie layer.

Attorney Docket: Beiersdorf 653

Office action, ¶ 5. One may ask, where does Wood disclose a tie layer disclosed between an outer layer and an inner layer as in the claimed laminate?

If the tie layer were between a nonelastic component and an elastomeric core, what properties would the tie layer have?

Without such disclosure, persons of ordinary skill would not reasonably arrive at a laminate with the properties of the claimed subject matter.

II. In addition, Wood's mere reference of a tie layer does not provide an enabling disclosure.

It is well established that a proper reference under 35 USC §§102 or 103 must be enabling in the sense of 35 USC §112, ¶1. However, Wood provides absolutely no guidance on how to modify Masatoshi, to arrive at claim 1. Thus, Masatoshi and Wood, combined are not enabling to the required extent.

Pertinent is the following quote from *In re Le Grice*, 133 USPQ 365, 374 (CCPA 1962):

"[T]he proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains *could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention* on which a patent is sought. [Emphasis added.]"

See also, *In re Hoeksema*, 158 USPQ 596, 601 (CCPA 1968), wherein the Court stated:

"While *In re Le Grice* was bottomed on an issue arising under 35 U.S.C. 102 where the reference was a 'printed publication,' that test, in our view, is also properly applicable to issues arising under 35 U.S.C. 103."

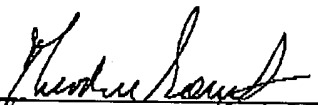
Attorney Docket: Beiersdorf 653

In sum, Wood does not sufficiently enable one to add a tie layer to any laminate, let alone his own, to the extent that she places the claimed subject matter in the public's possession.

It is respectfully requested that the rejections be withdrawn as the claimed laminate is not anticipated by or obvious in view of the references.

Respectfully Submitted,

Norris, McLaughlin & Marcus
220 East 42 nd Street
New York, NY 10017
Telephone (212) 808-0700
Facsimile (212) 808-0844


Theodore Gottlieb, PhD
Reg. No. 42, 597

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. (703) 872-9310 on 18 December 2003

Theodore Gottlieb

[Typed or printed name of depositor]

Signature



Amendment to Claims Page 1 of 3
USPN 09/646,553 to Gillet, et al.,

CLAIMS PENDING AFTER AMENDMENT OF 24 APRIL 2003

Claim 1 (Currently amended) An elastic laminate ~~Laminate~~ composed of at least a first layer of an elastic polymer film and of a second layer of an elastic textile sheet, where the finished laminate has either a microembossed effect, a macroembossed effect, or both,

wherein a skin-accessible self-adhesive coating has been applied ~~onto~~ to the textile sheet-side.

and wherein the first layer is composed of two coextruded layers with an outer layer and a tie layer, where the tie layer is composed of pure thermoplastic polyolefins, ~~without addition of additives or colorants;~~

Claim 2 (Previously presented). Laminate according to Claim 1, wherein the weight per unit area of the polymer film is from 15 to 150 g/m², the weight per unit area of the textile sheet is from 25 to 200 g/m² or both.

Claim 3 (Previously presented). Laminate according to claim 1 wherein the polymer film of the first layer has a structure comprising more than one layer of a copolymer of ethylene and polar comonomers or of a mixture of LDPE and an LLDPE, prepared by a metallocene-catalysed process.

Claim 4 (Previously presented). Laminate according to claim 1, wherein the polymer film of the first layer is a copolymer of ethylene and an α -olefin having a carbon number from C₄-C₁₂, where the copolymer has a melt index of from 1 to 20 g/(10 min) and density offrom 860 to 900 kg /m³.

Claim 5 (Canceled).

Claim 6 (Currently amended) The laminate ~~Laminate~~ according to claim 1, wherein the polymer film of the first layer comprises at least 65 wt.-% of a thermoplastic elastomer.

Claims 7-14 (Canceled).

Claim 15 (Previously presented). The laminate of claim 1, wherein only the polymer film layer is embossed.

Claim 16 (Previously presented). The laminate of claim 15, wherein the polymer film layer is microembossed.

Claim 17 (Previously presented). The laminate of claim 1, wherein the textile layer is macroembossed.

Claim 18 (Previously presented). The laminate of claim 17, wherein the textile layer is microembossed.

Claim 19 (Previously presented). The laminate of claim 1, wherein the first and second layers are macroembossed.

Claim 20 (Previously presented). The laminate of claim 1, wherein the first and second layers are microembossed.

Claim 21 (New) The laminate of claim 1, wherein the laminate shows no more than 10% permanent deformation in either the transverse or longitudinal direction after elongation of 50% of its original length.

Claim 22 (New) The laminate of claim 1, wherein the laminate shows no more than 10% permanent deformation in either the transverse or longitudinal direction after elongation of 100% of its original length.

Claim 23 (New) An elastic laminate backing material consisting essentially of elastic layers, the laminate composed of at least a first layer of an elastic polymer film and of a second layer of an elastic textile sheet,

wherein the finished laminate has either a microembossed effect, a macroembossed effect, or both,

wherein to the textile sheets is applied a skin-accessible self-adhesive coating,

and wherein the first layer is composed of two coextruded layers with an outer layer and a tie layer, where the tie layer is composed of pure thermoplastic polyolefins.